

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed February 21, 2007.

By this Amendment, Applicants cancel claims 3-5, 28-30, 51, and 66-86, without prejudice or disclaimer, amend independent claims 1, 26, and 50, and add new claims 87-94. The originally-filed specification, drawings, and claims fully support the subject matter of amended independent claims 1, 26, and 50 and new claims 87-94. For example, independent claims 1 and 26 have been rewritten to include the subject matter of cancelled dependent claims 5 and 30, respectively.

Before entry of this Amendment, claims 1-86 were pending in this application, with claims 66-86 having been withdrawn from consideration. After entry of this Amendment, claims 1, 2, 6-27, 31-50, 52-65, and 87-94 are pending in this application. Independent claims 1, 26, 50, and 91 are the sole independent claims.

On pages 2 and 6 of the Office Action, claims 50-52 and 56-63 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,643,307 to Turkel et al. ("Turkel"); and claims 53-55, 64, and 65 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Turkel. Applicants respectfully traverse this rejection.

Turkel does not disclose or suggest the claimed invention. For example, independent claim 50 recites an endoscopic instrument including, among other aspects, "wherein the second end effector has a non-straight portion connecting a tang to a cutting edge and configured to be received in a correspondingly-shaped gap in the holder." Turkel does not disclose or suggest at least this aspect of independent claim 50 either alone or in combination with the other aspects. Indeed, Turkel does not

disclose a tang. Moreover, the Section 103(a) rejection on page 6 of the Office Action does not address the aforementioned deficiency of Turkel.

New dependent claim 89 recites "wherein the holder has a groove for receiving a protrusion on the second end effector, wherein at least one of the groove and the protrusion is circumferentially-oriented." Turkel discloses stationary jaw 22, movable jaw 24, and sleeve 50, with stationary jaw 22 disposed within sleeve 50. Stationary jaw 22 includes ramped projections 40, 42 and distal tab projection 44 disposed through respective side openings 56, 58 and distal end opening 60 of sleeve 50. Even assuming *arguendo* that these aspects correspond to the protrusion and groove set forth in claim 89, Turkel still does not disclose the claimed subject matter because neither ramped projections 40, 42 nor distal tab projection 44 are circumferentially-oriented.

Accordingly, for at least these reasons, Applicants respectfully request withdrawal of the Section 102(b) and 103(a) rejections based on Turkel.

On pages 3-5 of the Office Action, claims 1-4, 6-15, and 17-25 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over WO Patent Application Publication No. WO 01/30242 A1 to Paternuosto ("Paternuosto") in view of U.S. Patent No. 4,763,669 to Jaeger ("Jaeger"). Independent claim 1 has been rewritten to include the subject matter of dependent claim 5, which was not rejected as being unpatentable over Paternuosto in view of Jaeger. Accordingly, Applicants respectfully request withdrawal of this rejection.

On pages 5-6 of the Office Action, claims 16 and 26-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paternuosto in view of Jaeger and further in

view of U.S. Patent No. 5,707,392 to Kortenbach ("Kortenbach ") or U.S. Patent No. 5,478,350 to Kratsch et al. ("Kratsch"). Applicants respectfully traverse this rejection.

No combination of Paternuosto, Jaeger, Kortenbach, and Kratsch discloses or suggests the claimed invention. For example, independent claim 26 recites an endoscopic instrument including, among other aspects, "wherein the holder has a groove for receiving both a protrusion on the cutting portion and a protrusion on the storage portion." No combination of Paternuosto, Jaeger, Kortenbach, and Kratsch discloses or suggests at least these aspects of independent claim 26 either alone or in combination with its other aspects.

Page 5 of the Office Action asserts that "Paternuosto as modified by Jaeger discloses the invention as claimed with the exception of the curved part of the tang and the proximal handle/control member." To the extent that the Office Action therefore relies on Paternuosto and Jaeger as disclosing all of the aspects of claims 16 and 26-65 except the two mentioned, Applicants respectfully disagree. For example, independent claim 26 has been rewritten to include the subject matter of claim 30. Paternuosto and Jaeger do not disclose that subject matter, i.e., the holder having a groove for receiving both a protrusion on the cutting portion and a protrusion on the storage portion. Furthermore, neither Kortenbach nor Kratsch is cited as remedying this deficiency of Paternuosto and Jaeger.

In another example, dependent claim 16 recites "wherein the cutting portion has a non-straight portion connecting a tang to a cutting edge and configured to be received in a correspondingly-shaped gap in the holder." Dependent claims 40 and 89 each recites similar aspect. Independent claim 50 recites an endoscopic instrument

including, among other aspects, "wherein the second end effector has a non-straight portion connecting a tang to a cutting edge and configured to be received in a correspondingly-shaped gap in the holder."

Page 5 of the Office Action acknowledges that Paternuosto and Jaeger do not disclose "the curved part of the tang." The Office Action relies on Kortenbach or Kratsch as disclosing tangs. In particular, the Office Action then cites inward z-bend 61 of tang 60 of Kortenbach and curved surface 206 of the tangs of Kratsch as corresponding to "the curved part of the tang." Even assuming arguendo that this is correct, the Office Action does not disclose how the cutting portion of independent claim 1, and particularly the curved part of the tang, is "configured to be received in a correspondingly-shaped gap in the holder." As the Office Action acknowledges that neither Paternuosto and Jaeger discloses "the curved part of the tang," it follows that those references also do not disclose "a correspondingly-shaped gap in the holder" for the curved part of the tang. Moreover, as neither Kortenbach nor Kratsch disclose holders, those references also cannot disclose "a correspondingly-shaped gap in the holder" for the curved part of the tang. Furthermore, col. 2, lines 32-33 of Kortenbach and col. 1, lines 57-60 of Kratsch both disclose minimizing costs and reducing manufacturing complexity as desirable factors. To manufacture holders (increasing both complexity and costs, especially if the gap must also be produced in the holder) for what otherwise appear to be adequate biopsy forceps jaws goes against advantages of those respective inventions.

Accordingly, for at least these reasons, Applicants respectfully request withdrawal of the Section 103(a) rejections based on Paternuosto, Jaeger, Kortenbach, and Kratsch.

New independent claim 91 recites an end effector assembly for obtaining multiple tissue samples including, among other aspects, "wherein a protrusion or a recess on the cutting portion is configured to mate with a recess or a protrusion on the storage portion." Page 4 of the Office Action recites that "[t]he holder portion [in Paternuosto] has a groove shown in fig. 9 for receiving a lip on the storage portion." Even assuming *arguendo* that this is correct, Fig. 9 of Paternuosto does not disclose that the groove mates with the lip as set forth above.

Applicants further submit that claims 2, 6-25, 27, 31-49, 52-65, 87-90, and 92-94 depend either directly or indirectly from one of independent claims 1, 26, 50, and 91, and are therefore allowable for at least the same reasons that independent claims 1, 26, 50, and 91 are respectively allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by the cited references, and therefore at least some also are separately patentable.

For example, new claims 87, 88, 90, and 93 each recite a device including, among other aspects, "wherein the tang defines a pivot bore and an actuator hole, and the non-straight portion is between the tang and the cutting edge." As shown in Fig. 7 of Kortenbach, the inward z-bend 61 of tang 60 (the alleged non-straight portion) is not between the tang and the cutting edge as set forth above. Moreover, as shown in Figs. 12 and 14 of Kratsch, tangs 100, 200 do not include "a pivot bore and an actuator hole" as set forth above.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.


In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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